## REMARKS

The Applicant respectfully requests entry of the above amendment and reconsideration in view of the amendment and the remarks herein.

The status of the claims in the above-identified application is as follows. Claims 1- 34 were originally presented. Claims 1-19, 21, 40 and 52 were previously cancelled. Claims 65 and 66 are cancelled herein. Claims 23-34 were withdrawn from consideration. Claims 35-73 were previously added. Thus, claims 20, 22, 35-39, 41-51, 53-64, and 67-73 remain pending.

Claims 45-47 and 60-62 are allowed. Applicant gratefully acknowledges the allowance.

Claims 41, 43 and 53 are objected to. Said claims have been cosmetically changed to address the objection.

Claims 20, 22, 35-39, 41-44, 48-51, 53-59, and 63-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over BOSCH marketing material (hereinafter "Bosch") in view of De Stoutz (U.S Patent No. 3,934,042).

The above stated rejections under 35 U.S.C. §103(a) are respectfully traversed in that the combination cited by the Examiner (i.e., Bosch with De Stoutz) does not anticipate the claims. The combination of Bosch and De Stoutz does not teach, or suggest, all of the elements of the claims, as required under 35 U.S.C. §103(a). There are at least two reasons why the Examiner has not proven a case of obviousness, and therefore the rejection must be removed.

The prior art must each or suggest all of the claim limitations. *See In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)("All words in a claim must be considered in judging the patentability of that claim against the prior art.") For example, Bosch does not teach, or suggest, "wherein said plurality of bottles are in an **upright position** during disinfecting," (emphasis added) as disclosed in independent claim 20, as amended. Nor does Bosch teach, or suggest, "further wherein said plurality of bottles are in an **upright position**,"(emphasis added) as disclosed in independent claim 22, as amended.

The Examiner states in the Office Action, on page 4, that "Bosch does not disclose that the

bottles are in an upright position during disinfecting. However it would have been an obvious matter of design choice to have modified Bosch's method and apparatus by having the bottles in an upright position during disinfecting, since applicant has not disclosed that bottles are in an upright position during disinfecting solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with disinfecting the bottle upside down as suggested by Bosch. (See Office Action, page 4).

First, Applicant respectfully traverses the Examiner's allegation that to have the bottles in the upright position during disinfection is a obvious matter of design choice. The Examiner has offered no evidence or support of this allegation from the prior art. In order to establish a *prima facie* case of obviousness, there must be a reasonable expectation of success to modify or combine references, and there must be motivation in the prior art to modify or combine referenced. *See e.g., In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442, (Fed. Cir. 1991) (Reversing the Boards obviousness rejections, and noting that the primary reference failed to suggest the modification alleged to be obvious, and stating that "the suggestion and the reasonable of success **must be founded in the prior art**, not in the applicant's disclosure.")(emphasis added). There is simply no suggestion, teaching, or disclosure in Bosch offered by the Examiner that *inter alia* certain disinfecting rates (e.g., greater than 100 bottles per minute) are obtainable *along with* certain disinfection levels (e.g., aseptically disinfected bottles; aseptically filled; and, aseptically sterilized foodstuffs) *along with* having bottles in an upright position.

Second, the independent claims, as amended, are not obvious in light of the cited art, in that the combination of elements in the claims are not a result-effective variable. Only a result-effective variable is optimizable by routine experimentation. *See e.g., In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). (Reversing the Board's obviousness rejection. The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result-effective variable.) To the contrary, the Examiner has offered no evidence in the art that the claimed disinfection levels (i.e., "aseptic") are not related to, or effected by, the claimed disinfection speeds (i.e, greater than 100 bottles per minute). Likewise, the Examiner has

offered no evidence that the disinfection levels and/or speeds are related to, or effected by, having the bottles upright during disinfection. Clearly, by having bottles in the upside down position during disinfection, as in the cited art, would be a clear teaching away from the present invention (i.e., containers in an upright position). It is not an obvious design choice to simply flip the container over (from Bosch) to obtain portions of the claimed invention *while concurrently obtaining* heretofore unobtainable disinfection rates and disinfection levels. Thus, Applicant contends that the rejection is incorrect and should be withdrawn.

## CONCLUSION

Applicant respectfully contends that based upon the aforementioned amendments and remarks that claims 20, 22, 35-39, 41-51 and 53-73, and the entire application, are in condition for allowance. If the Examiner believes that anything further is necessary in order to place the application in better condition for allowance, the Examiner is requested to contact Applicant's undersigned representative at the telephone number listed below.

The Honorable Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-0513.

Dated: July 8, 2004

Joseph J. Christian
Reg. No. 51,560
Schmeiser, Olsen & Watts
3 Lear Jet Lane - Suite 201
Latham, New York 12110
(518) 220-1850